



Attorney Docket 116.065

#32
1625

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Irving M. Fishman
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Irving M. Fishman
Signature

April 25 2006
Date

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF

Group Art Unit: 1625

BENNEKER, et al

Examiner: Chang

SERIAL NO: 09/200,743

FILED: November 30, 1998

FOR: 4-PHENYLPYPERIDINE COMPOUNDS

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P.O. Box 1450

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Withdrawal of Previously Filed
Terminal Disclaimer

Sir:

Further to the above-identified application, Applicant respectfully requests that the Terminal Disclaimer dated January 31, 2001, be withdrawn and deemed of no effect in the present application. Applicant submits that the Terminal Disclaimer was filed due to the presence of claim 39. After the Terminal disclaimer was filed, the Examiner entered a Restriction Requirement where claim 39 was Group II. Applicant elected Group I and canceled claim 39. Thus, upon cancellation of claim 39, the reason for the Terminal Disclaimer was no longer in the case. Hence, Applicant respectfully requests that the Terminal Disclaimer be removed.

More specifically, in the prosecution of the parent case, the Examiner entered a Restriction Requirement. US 09/200,743 was then filed as a Division of the parent case and directed to subject matter which was non-elected in the parent case. In a Preliminary Amendment in 09/200,743, Applicant also added claim 39, which was not part of the non-elected subject matter and did require a Terminal Disclaimer over the issuing parent (US 5,874,447) claim 7, if instant claim 39 were to issue. On 4/26/2001, the Examiner instituted a Restriction Requirement between claims 30-38 (all non-elected subject matter of the parent application) and claim 39 (the basis for Applicant having submitted the Terminal Disclaimer). On May 29, 2001, Applicant elected claims 30-38 and cancelled claim 39. On August 2, 2001, the examiner advised that claims 30-38 were allowable, but that due to a potential Interference, ex parte prosecution was suspended.

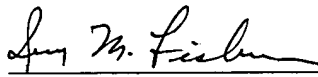
As can be seen, the basis for the Terminal Disclaimer, claim 39, was removed and claims 30-38 did not require any such Terminal Disclaimer. Since claims 30-38 are the only claims in the case, there is no need for the Terminal Disclaimer and Applicant respectfully requests that the Terminal Disclaimer be held withdrawn and/or be deemed a nullity.

Should this paper be deemed insufficient to withdraw the Terminal Disclaimer, Applicant respectfully requests that the Examiner advise the undersigned of the desired procedure to effectuate the purpose of this paper.

Respectfully submitted,

Date: April 25, 2006

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